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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/771,546 | 01/29/2001 | Robert Barra | P-1 CIP MG | 9594 |
| 28752 7590 07/30/2007 LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583 | | | EXAMINER HEWITT II, CALVIN L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |
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| | | | 07/30/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/771,546

Applicant(s)

BARRA ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Status of Claims

1. Claims 34-45 have been examined.

Response to Arguments

2. Applicant is attempting to claim benefit to Application 09/578,756.

However, this Application is silent the following:

- *information remains available at said mail center following receipt of the requested specified service(s) notwithstanding possible deletion of said information from said at least one of said sending and receiving computers;*
- *sending an authentication database*

Therefore, the prior art the prior art of Wu is valid. Helferich on the other hand clearly claims priority to a provisional application filed on March 29, 1999, hence it is considered valid prior art.

In general, Applicant is attempts to distinguish the claimed methods from the prior art by relying on a "whereby" clause that merely states the results of the claim, method steps that are not performed and non-functional descriptive material. For example, claim 34 recites "whereby said information remains available at said mail center following receipt of the requested service(s)..." To

one of ordinary skill this is inherent to email (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001). Further, the claim clearly states that information is stored by the mail center (i.e. storing at least said information by said mail center), hence one of ordinary skill would not expect the information to be suddenly un-stored or deleted. Claim 34 also recites “notwithstanding *possible* deletion”, while claim 36 recites “storing *said record*”, claim 37 recites “*said alert message*” and claim 41 recites “sending said information from said sending computer to a mail center *for authentication and storage*” (e.g. claim 41 recites an authentication database however authentication is not performed using the database only a comparing step). In each instance, however, none of these processes are actually performed. More specifically, there is not an attempt at deletion, a record, a sending of an alert message or an authentication of a message. According to the MPEP (§2106 II C), language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (see also *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006), *Intel Corp. v. Int’l Trade Comm’n*, 20 USPQ2d 1161 (Fed. Cir. 1991)), therefore these “limitations” will not differentiate the claims from the prior art. Regarding the information being sent (claim 39), further describing the

information will not further limit the claims as the type of information is not functionally related to the memory on which the information is stored (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

The Examiner maintains the rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helferich (U.S. PG Pub No. 2005/0176451 A1) in view of Wu (U.S. PG Pub No. 2001/0007993).

As per claims 34, 37 and 38, Helferich teach a method of transmitting information which contains a request for specified services on an e-mail system comprising:

- connecting a sending computer to a communication network (figure 1, item 145)

- submitting the information and a request from the sending computer to the communication network (paragraphs 88-92)
- inputting the information onto a website server (paragraph 98)
- transmitting, by the website server, the information to a mail center and receiving and storing the information at the mail center (paragraphs 98 and 99)
- sending requested specified services to a receiving computer that indicates that said information has been received (e.g. AOL or Microsoft Hotmail interface) (paragraph 55) a receiving computer indicating that the information has been received
- archiving data at the mail center (paragraphs 100 and 106)
- comprising inputting the information into a software program on the website server that interprets the information (paragraphs 75, 76, 79, and 88-92)
- confirming by said mail center that the receiving computer has received said information (paragraph 55)
- composing information on a sending computer and sending the information to a software program on the sending computer (figure 1, items 145 and 150; paragraphs 75, 76, 79, and 88-92)

- processing the information at the mail center (paragraphs 98 and 99) and sending the information from the mail center to a receiving computer (paragraphs 98 and 99)
- an authentication database for comparing the authentication database with a database on the sending computer (paragraph 75)
- retrieving a message from a software program (paragraph 74)

As per claims 40, 42, 44 and 45, by Applicant's own admission, authenticating a receiving computer (e.g. 128 bit encryption, SSL- page 5, lines 7-10) and confirming by a mail center that a receiving computer has receiving information (page 6, lines 15-22; page 8, lines 15-22; page 9, lines 8-13) are old and well known. *Hence, Helferich is sufficient alone in terms of prior art.* Nonetheless, Wu also teaches a method wherein the information remains available at the mail center following receipt of the requested specified service(s) notwithstanding possible deletion of the information from the at least one of the sending and receiving computers (*see paragraphs 0016, 0039-0041*) and including an authentication database for comparing the authentication database with a database on the sending computer; sending the information from the sending computer to a mail center for authentication (*see paragraphs 0016, 0039-0041*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Helferich's invention to include Wu's method wherein the information remains available at the mail center following

receipt of the requested specified service(s) notwithstanding possible deletion of the information from the at least one of the sending and receiving computers because this would have provided an automatic detection and consolidating storage of common e-mail attachment files received in an e-mail communications server.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

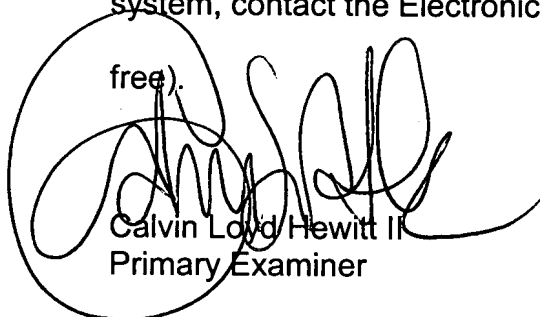
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Calvin Loyd Hewitt II
Primary Examiner

July 22, 2007